



#5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael J. Payne, et al.

Application No.: 09/965,230

Filing Date: September 25, 2001

For: COLOR AS A VISUAL CUE IN
SPEECH-ENABLED
APPLICATIONS

Examiner: Not Yet Assigned

Art Unit: Not Yet Assigned

RECEIVED

FEB 20 2002

OFFICE OF PETITIONS

Commissioner for Patents
Washington, D.C. 20231

DECLARATION OF MARK S. PELOQUIN

I, Mark S. Peloquin, having personal knowledge of the facts set forth herein, hereby declare and say as follows:

1. On September 25, 2001, the above referenced patent application was filed with the United States Patent and Trademark Office. The named inventors in the application are Michael J. Payne, Rohan Coelho, and Maher M. Hawash. Inventors Maher M. Hawash and Rohan Coelho are previous employees of Intel Corporation. Prior to filing, each of these inventors was sent a copy of the above referenced patent application, a Declaration, and an Assignment for their execution. Maher M. Hawash and Rohan Coelho have refused to cooperate with the prosecution of the above referenced patent application and have not executed the Declaration or Assignment.

2. After leaving the employment of Intel Corporation, Maher M. Hawash and Rohan Coelho were sent copies of the first draft for the above referenced patent application as indicated in Exhibit 1. Maher M. Hawash and

Rohan Coelho did not provide a review of the first draft of the above referenced patent application.

3. In response to Exhibit 1, Maher M. Hawash sent an email to me dated September 4, 2001 (Exhibit 2) indicating that he would not review the subject patent application unless he was paid on an hourly basis. This request for further compensation on the part of Maher M. Hawash was relayed to Intel Legal counsel Steven Skabrat (Exhibit 1).

4. Intel normally does not pay a patent filing honorarium fee to inventors that are no longer in their employment. However, in this case Intel would pay the honorarium fee if an inventor cooperated with the patent filing process (Exhibit 2). I relayed this information to Maher M. Hawash by telephone during the time period September 5–12, 2001. Maher M. Hawash told me that he would not provide a review of the above referenced patent application, neither would he execute the Declaration or Assignment documents.

5. On September 13, 2001 a letter, a final draft, a Declaration, and an Assignment were sent to Maher M. Hawash as indicated in Exhibit 3. Maher M. Hawash refused to execute the Declaration and Assignment.

6. With regard to Rohan Coelho, the letter, the final draft, the Declaration, and the Assignment documents (Exhibit 3) were sent to the last known address for Rohan Coelho. Rohan Coelho has not returned an executed Declaration and Assignment even after several requests via telephone messages to Rohan Coelho's home phone of (503) 690-8455, as indicated by the Declaration of Monique M. Pearson.

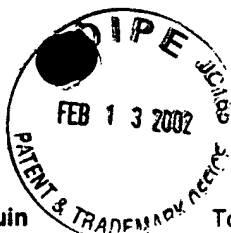
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful

false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: 1/31/2002

Mark S. Peloquin
Mark S. Peloquin
Reg. No. P-50,787

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025
(206) 292-8600



Mark Peloquin

09/05/01 11:33 AM

To: Monique Pearson/Bstz@BSTZ

cc:

Subject: RE: Patent Application review Ref: 42390P11780 & 42390P12154

Monique,
For the file.
Mark

----- Forwarded by Mark Peloquin/Bstz on 09/05/01 11:42 AM -----

Jim H Salter

09/05/01 10:50 AM

To: Mark Peloquin/Bstz@BSTZ

cc: Barbara Skliba/Bstz@BSTZ

Subject: RE: Patent Application review Ref: 42390P11780 & 42390P12154

Mark,

Please proceed on the basis recommended by Steve. Tnx. --jhs

----- Forwarded by Jim H Salter/Bstz on 09/05/01 10:47 AM -----



"Skabrat, Steven"
<steven.skabrat@intel.com>

09/05/01 10:50 AM

To: "Jim_Salter@bstz.com" <Jim_Salter@bstz.com>

cc: "Boulden, Janice" <janice.boulden@intel.com>,
Mark_Peloquin@bstz.com, Ed_Taylor@bstz.com,
Barbara_Skliba@bstz.com

Subject: RE: Patent Application review Ref: 42390P11780 & 42390P12154

We clearly will not pay any consulting fee to Mr. Hawash (or the others). I recommend that you tell Hawash, Coelho, and Allen that if they review the applications and provide feedback, that Intel will pay them the normal honorarium fee for filing (in this case \$500 for each of them payable AFTER filing). Normally we only pay the honorarium to current employees. However, in this case Intel can pay them to get their cooperation.

If they choose not to participate we shall go forward without them, using available means (uncooperative inventor).

These inventors are not employed by Intel any longer because their business was closed, so there may be some ill will here.

It would be better to get their comments, but proceed without them if necessary.

-----Original Message-----

From: Jim_Salter@bstz.com [mailto:Jim_Salter@bstz.com]

Sent: Wednesday, September 05, 2001 9:35 AM

To: Steven.Skabrat@intel.com

Cc: Janice.Boulden@intel.com; Mark_Peloquin@bstz.com;

Ed_Taylor@bstz.com; Barbara_Skliba@bstz.com

Subject: Patent Application review Ref: 42390P11780 & 42390P12154

Steve,

This situation probably needs your intervention. Please let us know how you would like us to proceed.

Thanks, Jim Salter ---jhs

----- Forwarded by Jim H Salter/Bstz on 09/05/01 09:25 AM -----

Mark Peloquin

09/05/01
 Monique Pearson/Bstz@BSTZ
 08:48 AM
 review Ref: 42390P11780 & 42390P12154

To: Jim H Salter/Bstz@Bstz
 cc: Mark Peloquin/Bstz@BSTZ,
 Subject: Patent Application

Jim,

We have a problem getting sufficient inventor review on the two Intel applications referenced above. There are four inventors on P11780 and three inventors on P12154 broken down as shown below. Intel grouped together multiple disclosures that ultimately formed these patent applications.

P11780: Rohan Coelho, Maher Hawash, Michael Payne, Karl Allen
 P12154: Rohan Coelho, Maher Hawash, Michael Payne

So far we have received a review from Mike Payne, he is the only inventor remaining at Intel under employment. Mike suggests that both Karl Allen and Rohan Coelho review the applications. Maher Hawash, another inventor, now requests that he be paid to perform a review.

At one point the inventors who have left Intel were talking about licensing these patent applications from Intel and pursuing this technology on their own.

I have not called any of the Intel inventors who have left Intel yet. How shall we proceed, and if I call Karl or Rohan and they also request payment how shall I handle that situation?

Mark

----- Forwarded by Mark Peloquin/Bstz on 09/05/01 08:23 AM -----

Adele Hysen

09/04/01
 04:18 PM
 review Ref: 42390P11780 & 42390P12154

To: Mark Peloquin/Bstz@BSTZ
 cc:
 Subject: Patent Application

----- Forwarded by Adele Hysen/Bstz on 09/04/2001 04:18 PM -----

"Maher Hawash" <hawash@pacifier.com> on 09/04/2001 03:05:23 PM

To: <bstz_mail@bstz.com>
cc:
Subject: Patent Application review Ref: 42390P11780 & 42390P12154

Please forward to Mark Peloquin

Hi Mark:

I just received the patent application today. I don't work for Intel anymore, and would not be able to review this material for them without proper compensation. I am currently in the process of starting my consulting business and would be willing to review it on that basis. My rate is \$175/hr.

Please let me know if you would like to proceed, or if I should return the material to you.

Best Regards,

Maher Hawash

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

A LIMITED LIABILITY PARTNERSHIP INCLUDING LAW CORPORATIONS

TELEPHONE (408) 720-8300

FACSIMILE (408) 720-8383

BSTZ_MAIL@BSTZ.COM
WWW.BSTZ.COM

INTELLECTUAL PROPERTY LAW

SILICON VALLEY OFFICE

1279 OAKMEAD PARKWAY
SUNNYVALE, CALIFORNIA 94085-4040

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PORTLAND/LAKE OSWEGO, OR
SEATTLE/KIRKLAND, WA
DENVER/ENGLEWOOD, CO**CONFIDENTIAL**
ATTORNEY-CLIENT PRIVILEGED
September 13, 2001Maher Hawash
2642 NE Aurora Drive
Hillsboro, OR 97124**Re: UNITED STATES PATENT APPLICATION FOR:**
"SPEAKER INDEPENDENT VOICE RECOGNITION (SIRV) USING DYNAMIC
ASSIGNMENT OF SPEECH CONTEXTS, DYNAMIC BIASING, AND
MULTI-PASS PARSING" and "COLOR AS A VISUAL CUE IN
SPEECH-ENABLED APPLICATIONS"**Our Ref: 42390.P11780 and 42390.P12154**

Dear Mr. Hawash

Enclosed with this letter is a final draft of the above-referenced patent applications, and the legal documents necessary to file the application in the United States Patent and Trademark Office. The legal documents include:

- 1). an **Assignment** to transfer rights, interest, and property in the above-referenced application to Intel Corporation., the assignee of the present invention; and
- 2). a **Declaration and Power of Attorney** to allow the law firm of Blakely, Sokoloff, Taylor, and Zafman, LLP to prosecute the above-referenced application on your behalf before the United States Patent and Trademark Office.

Please review the drafts to ensure that they includes a complete and accurate description of your inventions. If corrections need to be made, or if you mark the final drafts, please notify us immediately, as a new copy of the application, together with new assignment and declaration documents will need to be forwarded for your review and signature.

If you find the applications acceptable, please execute the attached assignment and declaration documents, and return them to our offices as soon as possible, preferably **no later than Monday, September 17, 2001**. If the residence, citizenship, and mailing address fields underneath your name are empty, please insert the appropriate information prior to signing. Please fax the executed documents to 408.720.8383, and mail the signed originals in the enclosed prepaid Fed-Ex envelope provided.

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

A LIMITED LIABILITY PARTNERSHIP INCLUDING LAW CORPORATIONS

Maher Hawash
Attorney Docket No.: 42390.P11780
and 42390.P12154
September 13, 2001
Page 2

Signing the enclosed Declaration and Power of Attorney, affirms that you are an actual inventor of the subject matter claimed in the above referenced patent application. United States law defines an inventor as any person who conceived of some aspect of the subject matter recited in the claims. If, based on this definition, you do not believe you are an inventor, or if you believe that one or more other persons should be listed as co-inventors, please notify us immediately, as new documents will need to be prepared for your review and signature.

During your review, please bear in mind that the application must disclose your preferred way of carrying out the invention. If special preferred materials or configurations were not mentioned or described, please bring them to our attention.

It is our understanding that the invention has not been patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country, more than one year prior to the date that we intend to file this application. If you believe otherwise, please inform us as soon as possible.

In closing, please remember your continuing duty to disclose to the Patent and Trademark Office any information you are aware of that is material to the issuance of your patent application. A search of the prior art is not required, but if you know of any printed publications bearing on your invention, such as articles, prior patent applications, etc., please bring them to our attention. The duty to disclose prior art materials is called a continuing duty because it lasts throughout the entire prosecution of your patent application.

Please note that notarization is not necessary if it is not readily available.

We look forward to receiving your response in due course.

Sincerely,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Mark S. Peloquin, Esq.

Mark S. Peloquin, Esq.

MSP/mmp

Encl: Patent Application with Drawings
Assignment
Declaration and Power of Attorney

Attorney's Docket

ASSIGNMENT**PATENT**No.: 42390P12154 (For Execution Prior To Filing Patent Application)

In consideration of good and valuable consideration, the receipt of which is hereby acknowledged, We
 the undersigned, Michael Payne, Rohan Coelho, and Maher M. Hawash

hereby sell, assign, and transfer to Intel Corporation
 a corporation of Delaware, having a principal place of business at
2200 Mission College Blvd., Santa Clara, California 95052, ("Assignee"),
 and its successors, assigns, and legal representatives, the entire right, title, and interest for the
 United States and all foreign countries, in and to any and all improvements that are disclosed in
 the application for the United States patent that has been executed by the undersigned prior
 hereto or concurrently herewith on the dates indicated below and is entitled COLOR AS A
VISUAL CUE IN SPEECH-ENABLED APPLICATIONS

and in and to said application and all divisional applications, continuation applications,
 continued prosecution applications, continuation-in-part applications, substitute applications,
 renewal applications, reissue applications, reexaminations, extensions, and all other patent
 applications that have been or shall be filed in the United States and all foreign countries on
 any of said improvements; and in and to all original patents, reissued patents, reexamination
 certificates, and extensions, that have been or shall be issued in the United States and all
 foreign countries on said improvements; and in and to all rights of priority resulting from the
 filing of said United States application;

agree that said Assignee may apply for and receive a patent or patents for said
 improvements in its own name; and that, when requested, without charge to, but at the
 expense of, said Assignee, its successors, assigns, and legal representatives, to carry out in
 good faith the intent and purpose of this Assignment, the undersigned will execute all divisional
 applications, continuation applications, continued prosecution applications, continuation-in-part
 applications, substitute applications, renewal applications, reissue applications, reexaminations,
 extensions and all other patent applications on any and all said improvements; execute all
 rightful oaths, assignments, powers of attorney, and other papers; communicate to said
 Assignee, its successors, assigns, and representatives all facts known to the undersigned
 relating to said improvements and the history thereof; and generally assist said Assignee, its
 successors, assigns, or representatives in securing and maintaining proper patent protection
 for said improvements and for vesting title to said improvements, and all applications for
 patents and all patents on said improvements, in said Assignee, its successors, assigns, and
 legal representatives; and

covenant with said Assignee, its successors, assigns, and legal representatives that no
 assignment, grant, mortgage, license, or other agreement affecting the rights and property
 herein conveyed has been made to others by the undersigned, and that full right to convey the
 same as herein expressed is possessed by the undersigned.

Each Inventor: Please Sign and Date Below:

_____, 20____	_____
Date	Name: Michael J. Payne
_____, 20____	_____
Date	Name: Rohan Coelho
_____, 20____	_____
Date	Name: Maher M. Hawash
_____, 20____	_____
Date	Name:
_____, 20____	_____
Date	Name:
_____, 20____	_____
Date	Name:

Each Inventor: Please also list the date that you signed the accompanying DECLARATION AND POWER OF ATTORNEY:

_____, 20____
Date
_____, 20____
Date
_____, 20____
Date
_____, 20____
Date
_____, 20____
Date
_____, 20____
Date

State of: _____ }
 County of: _____ } SS.

Assignment Document Return Address:
 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
 12400 Wilshire Blvd., Seventh Floor
 Los Angeles, CA 90025-1026
 (408) 720-8598

On this _____ day of _____, 20____, before me, _____,
 the undersigned Notary Public, personally appeared _____
☐ personally known to me ☐ proved to me on the basis of satisfactory evidence to be the
 person(s) whose name(s) _____ subscribed to the within instrument, and acknowledged
 that _____ executed it.
 WITNESS my hand and official seal.

 Notary's Signature

<u>Prior Foreign Application(s)</u>			<u>Priority Claimed</u>	
<u>(Number)</u>	<u>(Country)</u>	<u>(Foreign Filing Date - MM/DD/YYYY)</u>	<u>Yes</u>	<u>No</u>
<u>(Number)</u>	<u>(Country)</u>	<u>(Foreign Filing Date - MM/DD/YYYY)</u>	<u>Yes</u>	<u>No</u>
<u>(Number)</u>	<u>(Country)</u>	<u>(Foreign Filing Date - MM/DD/YYYY)</u>	<u>Yes</u>	<u>No</u>

I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below:

<u>Application Number</u>	<u>(Filing Date - MM/DD/YYYY)</u>
<u>Application Number</u>	<u>(Filing Date - MM/DD/YYYY)</u>

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

<u>Application Number</u>	<u>(Filing Date - MM/DD/YYYY)</u>	<u>Status -- patented, pending, abandoned</u>
<u>Application Number</u>	<u>(Filing Date - MM/DD/YYYY)</u>	<u>Status -- patented, pending, abandoned</u>

I hereby appoint the persons listed on Appendix A hereto (which is incorporated by reference and a part of this document) as my respective patent attorneys and patent agents, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

Send correspondence to James H. Salter, BLAKELY, SOKOLOFF, TAYLOR &
(Name of Attorney or Agent)

ZAFMAN LLP, 12400 Wilshire Boulevard 7th Floor, Los Angeles, California 90025 and direct
telephone calls to James H. Salter, (408) 720-8300.
(Name of Attorney or Agent)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Sole/First Inventor Michael J. Payne

Inventor's Signature 

Date 9/19/2001

Residence Beaverton, OR

(City, State)

Citizenship USA

(Country)

Post Office Address 8035 SW 160th Avenue, Beaverton, OR 97007

Full Name second/joint Inventor Rohan Coelho

Inventor's Signature _____

Date _____

Residence _____

(City, State)

Citizenship _____

(Country)

Post Office Address _____

Full Name of third/joint Inventor Maher M. Hawash

Inventor's Signature _____

Date _____

Residence Hillsboro, OR

(City, State)

Citizenship USA

(Country)

Post Office Address 2642 NE Aurora Drive, Hillsboro, OR 97124

APPENDIX A

William E. Alford, Reg. No. 37,764; Farzad E. Amini, Reg. No. 42,261; William Thomas Babbitt, Reg. No. 39,591; Carol F. Barry, Reg. No. 41,600; Jordan Michael Becker, Reg. No. 39,602; Lisa N. Benado, Reg. No. 39,995; Bradley J. Berezna, Reg. No. 33,474; Michael A. Bernadieu, Reg. No. 35,934; Roger W. Blakely, Jr., Reg. No. 25,831; R. Alan Burnett, Reg. No. 46,149; Gregory D. Caldwell, Reg. No. 39,926; Thomas M. Coester, Reg. No. 39,637; Donna Jo Coningsby, Reg. No. 41,684; Florin Corie, Reg. No. 46,244; Mimi Diemmy Dao, Reg. No. 45,628; Dennis M. deGuzman, Reg. No. 41,702; Stephen M. De Klerk, Reg. No. 46,503; Michael Anthony DeSanctis, Reg. No. 39,957; Daniel M. De Vos, Reg. No. 37,813; Justin M. Dillon, Reg. No. 42,486; Sanjeet Dutta, Reg. No. 46,145; Matthew C. Fagan, Reg. No. 37,542; Tarek N. Fahmi, Reg. No. 41,402; Thomas S. Ferrill, Reg. No. 42,532; George Fountain, Reg. No. 37,374; James Y. Go, Reg. No. 40,621; James A. Henry, Reg. No. 41,064; Libby N. Ho, Reg. No. 46,774; Willmore F. Holbrow III, Reg. No. 41,845; Sheryl Sue Holloway, Reg. No. 37,850; George W. Hoover II, Reg. No. 32,992; Eric S. Hyman, Reg. No. 30,139; William W. Kidd, Reg. No. 31,772; Sang Hui Kim, Reg. No. 40,450; Walter T. Kim, Reg. No. 42,731; Eric T. King, Reg. No. 44,188; George Brian Leavell, Reg. No. 45,436; Kurt P. Leyendecker, Reg. No. 42,799; Gordon R. Lindeen III, Reg. No. 33,192; Jan Carol Little, Reg. No. 41,181; Robert G. Litts, Reg. No. 46,876; Julio Loza, Reg. No. P47,758; Joseph Lutz, Reg. No. 43,765; Michael J. Mallie, Reg. No. 36,591; Andre L. Marais, Reg. No. P048,095; Paul A. Mendonsa, Reg. No. 42,879; Clive D. Menezes, Reg. No. 45,493; Chun M. Ng, Reg. No. 36,878; Thien T. Nguyen, Reg. No. 43,835; Thinh V. Nguyen, Reg. No. 42,034; Robert B. O'Rourke, Reg. No. 46,972; Daniel E. Ovanezian, Reg. No. 41,236; Kenneth B. Paley, Reg. No. 38,989; Gregg A. Peacock, Reg. No. 45,001; Marina Portnova, Reg. No. 45,750; William F. Ryann, Reg. No. 44,313; James H. Salter, Reg. No. 35,668; William W. Schaal, Reg. No. 39,018; James C. Scheller, Reg. No. 31,195; Jeffrey S. Schubert, Reg. No. 43,098; George Simion, Reg. No. P47,089; Maria McCormack Sobrino, Reg. No. 31,639; Stanley W. Sokoloff, Reg. No. 25,128; Judith A. Szepesi, Reg. No. 39,393; Edwin H. Taylor, Reg. No. 25,129; John F. Travis, Reg. No. 43,203; Joseph A. Twarowski, Reg. No. 42,191; Mark C. Van Ness, Reg. No. 39,865; Tom Van Zandt, Reg. No. 43,219; Brent E. Vecchia, Reg. No. P48,011; Lester J. Vincent, Reg. No. 31,460; Archana B. Vittal, Reg. No. 45,182; Glenn E. Von Tersch, Reg. No. 41,364; John Patrick Ward, Reg. No. 40,216; Mark L. Watson, Reg. No. 46,322; Thomas C. Webster, Reg. No. 46,154; and Norman Zafman, Reg. No. 26,250; my patent attorneys, and Firasat Ali, Reg. No. 45,715; and Raul Martinez, Reg. No. 46,904, my patent agents, of BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP, with offices located at 12400 Wilshire Boulevard, 7th Floor, Los Angeles, California 90025, telephone (310) 207-3800, and Alan K. Aldous, Reg. No. 31,905; Ben Burge, Reg. No. 42,372; Richard C. Calderwood, Reg. No. 35,468; Paul W. Churilla, Reg. No. P47,495; Jeffrey S. Draeger, Reg. No. 41,000; Cynthia Thomas Faatz, Reg. No. 39,973; John N. Greaves, Reg. No. 40,362; Seth Z. Kalson, Reg. No. 40,670; David J. Kaplan, Reg. No. 41,105; John Kacvinsky, Reg. No. 40,040; Peter Lam, Reg. No. 44,855; Charles A. Mirho, Reg. No. 41,199; Paul Nagy, Reg. No. 37,896; Leo V. Novakoski, Reg. No. 37,198; Thomas C. Reynolds, Reg. No. 32,488; Kenneth M. Seddon, Reg. No. 43,105; Mark Seeley, Reg. No. 32,299; Steven P. Skabrat, Reg. No. 36,279; Howard A. Skaist, Reg. No. 36,008; Steven C. Stewart, Reg. No. 33,555; Gene I. Su, Reg. No. 45,140; Calvin E. Wells, Reg. No. P43,256; Raymond J. Werner, Reg. No. 34,752; Robert G. Winkle, Reg. No. 37,474; Sharon Wong, Reg. No. 37,760; Steven D. Yates, Reg. No. 42,242; and Charles K. Young, Reg. No. 39,435; my patent attorneys, and Michael J. Nesheiwat, Reg. No. P47,819, my patent agent of INTEL CORPORATION; and James R. Thein, Reg. No. 31,710, my patent attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

APPENDIX BTitle 37, Code of Federal Regulations, Section 1.56
Duty to Disclose Information Material to Patentability

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.